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S/N: 09/474,418

REMARKS

Claims 1-24 are pending in the present application. In the Office Action mailed December 5, 2003, the Examiner rejected claims 1-24 under 35 U.S.C. §103(a) as being unpatentable over Canfield, II et al. (USP 5,897,498) in view of Eastvold et al. (USP 6,487,513). Additionally, claims 1-24 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-44 of Application No. 09/199,506.

**Background**

Canfield, II et al. was first made of record in the Office Action of February 3, 2003. However, the reference was not applied to the claimed invention until after Applicant overcame all previous rejections – which were obviousness-type rejections under §103(a). The Examiner then rejected each and every claim as anticipated by Canfield, II et al. – a previously known reference in an Office Action dated June 25, 2003. However, “[i]n rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command.” 37 CFR 1.104(c). Therefore, Applicant expressed confusion as to how the Examiner can later present a rejection under §102(e) when the reference previously considered by the Examiner to be the “best” reference was presented as a rejection under §103(a). Applicant requested clarification. However, the Examiner has not provided any explanation.

In the current Office Action mailed December 5, 2003, the Examiner acknowledged that the previous rejection under §102(e) based on Canfield, II et al. was unsustainable. As such, the Examiner rejected claims 1-24 as being unpatentable over Canfield, II et al. in view of Eastvold et al. It is noted that this application has been pending since December 29, 1999, and Applicant has not filed any RCE, CPA, or continuation of any kind. While Applicant appreciates the Examiner’s efforts to provide a thorough examination, Applicant believes the prosecution of this case is being unnecessarily prolonged.

Therefore, while Applicant acknowledges the Examiner’s duty to perform a thorough search and examination as outlined in MPEP §904.01, and appreciates the same, Applicant reminds the Examiner that it is also the Examiner’s duty to avoid delay in prosecution and unreasonably forestall a resolution of pending applications generally. See MPEP §904.03. Applying a reference that was previously considered insufficient to substantiate any rejection, then applying it as a §102 rejection, then applying it as a §103 rejection, appears to add nothing but unnecessary burden and cost to prosecution, for both the Applicant and the Office.

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**Rejection Under §103(a)**

To substantiate the current rejection, the Examiner has ignored explicit elements of the claims and misinterpreted the reference. The Examiner has ignored the fundamental differences in function and purpose between the claimed invention and that which is disclosed by Canfield, II et al. and Eastvold et al. For example, Canfield, II et al. teaches an "ultrasound diagnostic imaging system with electronic message communications capability." *Title of Canfield, II et al.* On the other hand, as was fully addressed in detail in the Response of August 22, 2003, the independent claims specifically call for "an in-field product...that is not readily capable of direct communications." *Claim 1.* Therefore, while the very focus and purpose of Canfield, II et al. is a system where the in-field product, i.e. an ultrasound system, is capable of direct communications, the claimed invention is directed to the exact opposite. That is, the claimed invention is directed to a system to allow remote communications, servicing and the like, when the in-field product is not readily capable of direct communications.

Nevertheless, the Examiner entirely ignored this fact and failed to respond to Applicant's arguments. Instead, the Examiner stated that "Canfield discloses...an in-field product at a customer site that is not readily capable of direct communication with the on-line center." (Emphasis added.) The Examiner's statement is not only incorrect, it is blatantly wrong as illustrated in the Response dated August 22, 2003.

Specifically, the Examiner asserted that column 2, lines 52-63 teaches "an in-field product...that is not readily capable of direct communication with the on-line center" and "at least one portable service interface operable with the in-field product." However, as clearly pointed out in the Response of August 22, 2003, the citation merely provides a general operational background of an ultrasound system and fails to address any element of the claim other than an "in-field product," i.e. ultrasound system. Continuing into column 3, which the Examiner did not cite, Canfield, II et al. teaches that "[t]he ultrasound system 10 includes a HyperText Transfer Protocol (HTTP) server 30." Col. 3, ll. 19-20, emphasis added. The integrated HTTP server allows the ultrasound system to directly communicate reports to a "personal computer, terminal, or workstation at a remote location." Col. 3, ll. 23-24. Therefore, Canfield, II et al. specifically teaches directly away from an in-field product that is NOT readily capable of direct communication with the on-line center and a portable service interface operable with the in-field product by teaching that the ultrasound system have integrated means for internet communications.

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The Examiner acknowledged that "Canfield does not explicitly disclose at least one on-line center having access to service software at a centralized facility so as to service in-field product remotely." However, the Examiner asserted that Eastvold et al. discloses such.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. MPEP §2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex Parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Intcr. 1985). That is, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP §2143.01. "The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness." *Id.* When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Applicant believes that a *prima facie* case of obviousness has not been established and one cannot be made based on the art of record. In combining these references, the Examiner is ignoring explicit shortcomings of the references, in the rejection, and the non-trivial distinctions clearly set forth in the Response mailed August 22, 2003.

As stated, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

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ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP §2143

Applicant believes that a *prima facie* case of obviousness cannot be made based on the art of record because, as will be detailed below, (1) the references are directed to very different purposes and there is no motivation to combine these references in a way done so by the Examiner, other than using Applicant's own teaching; (2) such a combination would not have a reasonable expectation of success; and (3) all the elements of the present claims are not present in the references. The Examiner has not established any one of the three basic criteria required under MPEP §2143. Applicant will now address each of these three criteria required by MPEP §2143.

First, Canfield, II et al. is direct to an "ultrasonic diagnostic imaging system with electronic message communications capability." *Title of Canfield, II et al.* (emphasis added). On the other hand, Eastvold et al. is directed to a "diagnostic test unit network and system." *Title of Eastvold et al.* (emphasis added). One in ordinary skill in the art would not be motivated to combine an electronic message communications system with a diagnostic test unit network in the hopes of yielding the claimed invention, i.e. a "system and method for remote servicing of in-field product...that is not readily capable of direct communication...." Simply, when seeking a system and method for remote servicing of in-field product, Canfield, II et al. and Eastvold et al. are nonanalogous art. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992).

Second, even if Canfield, II et al. and Eastvold et al. were to be combined, the combination would not successfully yield the claimed invention. The systems taught by Canfield, II et al. and Eastvold et al. both include an in-field product that IS readily capable of communications, whereas the claimed invention explicitly includes an in-field product that is NOT readily capable of direct communications. Therefore, the present invention solves a problem that is wholly inapplicable to the references. In fact, Canfield, II et al. is clear that the in-field products are readily capable direct communications. Col. 3, Ins. 19-20 and Col. 3, Ins. 23-24. Therefore, any combination of Canfield, II et al. and Eastvold et al., in an attempt to produce the claimed invention, would not have a reasonable expectation of success – with respect to the claimed invention. The Examiner cannot disregard claim limitations.

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Third, as explained above, all the elements of the present claims are not present in the references. Specifically, the systems taught by Canfield, II et al. and Eastvold et al. both include an in-field product that IS readily capable of communications while the claimed invention explicitly includes an in-field product that is NOT readily capable of direct communications.

Accordingly, the Examiner cannot sustain the present rejection because (1) the references are directed to very different purposes and there is no motivation to combine these references in a way done so by the Examiner; (2) the combination would not have a reasonable expectation of success; and (3) all the elements of the present claims are not present in the cited references. Not only has the Examiner not established all three of these required basic criteria under MPEP §2143, the Examiner has not even established one of them, and, therefore, the current rejection is not sustainable.

For all these reasons, Applicant believes claim 1 is patentably distinct from the cited art. Claims 2-9 are also in condition for allowance pursuant at least to the chain of dependency. Applicant highlighted some of the numerous elements that were not addressed by the Examiner and further distinguished the claimed invention from the cited art in the Response of August 22, 2003, and incorporates that response herein. The Examiner failed to respond to Applicant's remarks and merely asserted that the claims are obvious in light of the combination of Canfield, II et al. and Eastvold et al. The Examiner made no effort to address Applicant's arguments with respect to the new basis of rejection and merely restated the rejections of claims 2-9 provided in the Office Action mailed June 25, 2003, which did not include Eastvold et al. Therefore, Applicant reiterates the remarks made in the Response mailed August 22, 2003. As such, should the Examiner find Applicant's remarks unpersuasive, Applicant requests reasoned statements illuminating the Examiner's position for purposes of appeal.

Regarding claim 3, the Examiner cited column 8, lines 5-37 as teaching the claimed invention. First, as previously shown, Canfield, II et al. does not teach service software. Therefore, Canfield, II et al. does not teach that the service software be designed for utilization with "a wide variety of medical image scanner." Second, Canfield, II et al. does not teach "a wide variety of medical image scanners" but a system for use with only ultrasound type medical image scanners. The Examiner is reminded that to sustain a rejection under §102, the reference must teach each and every element of the claim. MPEP §2131. Third, claim 3 is specific that the on-line center "automatically downloads the selected service software." Canfield, II et al. teaches